

REMARKS/ARGUMENTS

The rejections presented in the Office Action dated September 7, 2006 (hereinafter Office Action) have been considered. Claims 1-62 remain pending in the application. Claims 37 and 50 have been amended. The Specification has been amended, without adding new matter. Reconsideration of the pending claims and allowance of the application in view of the present response is respectfully requested.

The Applicant makes note that a provisional election of species II, claims 1-8, 13-44, 47-57 and 60-62, with traverse, was made during a phone conversation with the Examiner on 08/23/2006. The Examiner withdrew claims 9-12, 45-46, and 58-59.

In support of the restriction, the Examiner states that "species I and II are mutually exclusive, not capable of use together." (Office Action, Page 2). However, the Examiner provides no support for this statement. The Applicant respectfully submits that no teaching from the Applicant's Specification supports the Examiner's contention that the species are mutually exclusive and not capable of use together. Both an external system and an internal system, as disclosed by the Applicant's Specification, could be used in conjunction with one another. As such, because the species identified by the Examiner are not mutually exclusive and are capable of use together, the Applicant respectfully requests withdrawal of the restriction between species I and II and prosecution of all pending claims.

The Examiner objects to the Specification for improper incorporation by reference, lack of application numbers, and lack of patent numbers where only application numbers were provided. The Applicant submits that the above amendments to the Specification resolve the issues identified by the Examiner. In addition, all references incorporated by references have published. U.S. Publication numbers have been provided in the amendments to the Specification for all references that have not yet issued as patents. As such, all instances of noncompliant incorporation by reference have been corrected, in compliance with 37 C.F.R. 1.57(g).

Claims 1-5, 8, 13-14, 19-25, 28-29, 33-41, 44, 47-54, 57 and 60-62 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Publication No. 2002/0035376 by

Bardy et al. (hereinafter "*Bardy '376*"). Claims 1-5, 8, 13-25, 28-41, 44, 47-54, 57 and 60-62 stand rejected under 35 U.S.C. §102(a) as being anticipated by U.S. Publication No. 2002/0091414 by *Bardy et al.* (hereinafter "*Bardy '414*").

To anticipate a claim, the reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Therefore, all claim elements, and their limitations, must be found in the prior art reference to maintain a rejection based on 35 U.S.C. §102.

In the rejection of independent claims 1, 21, 37, and 50, the Examiner repeatedly states that "the controller, in response to a cardiac condition requiring treatment, coordinating delivery of a selected *one of* the tachycardia, bradycardia, and asystole prevention therapies." (See Office Action, Pages 4-6, 8-9; emphasis original). The Applicant respectfully submits that while the quoted passage does correspond to a portion of independent claim 1, the Examiner appears to have not addressed other limitations recited in independent claim 1. For example, independent claim 1 also recites "energy delivery circuitry capable of delivering a plurality of cardiac therapies comprising at least a tachycardia therapy, a bradycardia therapy, and an asystole prevention therapy." Therefore, while the controller of independent claim 1 need only coordinate delivery of a selected one of the therapies, the claim nevertheless requires that the energy delivery circuitry be capable of delivering at least a tachycardia therapy, a bradycardia therapy, and an asystole prevention therapy.

Moreover, independent claim 21 recites "energy delivery circuitry provided in the housing and capable of delivering each of a tachycardia therapy, a bradycardia therapy, and an asystole prevention therapy." Also, amended independent claim 37 recites "delivering one of a plurality of available cardiac therapies to treat the detected cardiac condition, the plurality of cardiac therapies comprising at least a tachycardia therapy, a bradycardia therapy, and an asystole prevention therapy." In addition, amended independent claim 50 recites "delivering one of a plurality of cardiac therapies to treat the detected cardiac

condition, the plurality of cardiac therapies comprising at least a tachycardia therapy, a bradycardia therapy, and an asystole prevention therapy, all of which can be delivered by the system.”

As such, an anticipatory reference of independent claims 1, 21, 37, and 50 must disclose a tachycardia therapy, a bradycardia therapy, and an asystole prevention therapy. The Applicant respectfully submits that *Bardy* '376 and *Bardy* '414 each fail to teach at least an asystole prevention therapy. Moreover, neither *Bardy* '376 nor *Bardy* '414 even describe an asystolic condition. Therefore, the Applicant respectfully submits that neither *Bardy* '376 nor *Bardy* '414 teach each and every element and limitation of independent claims 1, 21, 37, and 50, and therefore fails to anticipate these claims.

Dependent claim 2-5, 8, 13-20, 22-25, 28-36, 38-41, 44, 47-49, 51-54, 57 and 60-62, which are dependent from independent claims 1, 21, 37, and 50, respectively, were also rejected under 35 U.S.C. §102(a) and (b) as being unpatentable over *Bardy* '414 and *Bardy* '376, respectively. While the Applicant does not acquiesce with the particular rejections to these dependent claims, it is believed that these rejections are now moot in view of the remarks made in connection with independent claims 1, 21, 37, and 50. These dependent claims include all of the limitations of the base claim and any intervening claims, and recite additional features which further distinguish these claims from the cited reference. Therefore, dependent claims 2-5, 8, 13-20, 22-25, 28-36, 38-41, 44, 47-49, 51-54, 57 and 60-62 are also not anticipated by *Bardy* '414 nor *Bardy* '376.

For at least these reasons, the Applicant respectfully submits that the rejection of claims 1-5, 8, 13-25, 28-41, 44, 47-54, 57 and 60-62 as being anticipated by *Bardy* '414 or *Bardy* '376 is not sustainable.

Claims 6, 26, 42 and 55 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Bardy* '376 as applied to claims 1, 21, 37 and 50 and further in view of U.S. Patent No. 4,562,841 to *Brockway et al.* (hereinafter "*Brockway*"). Claims 6, 26, 42 and 55 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Bardy* '414 as applied to claims 1, 21, 37 and 50 and further in view of *Brockway*. Claims 7, 27, 43 and 56 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Bardy* '376 as applied

to claims 1, 21, 37 and 50 and further in view of U.S. Patent No. 5,814,079 to *Kieval et al.* (hereinafter "*Kieval*"). Claims 7, 27, 43 and 56 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Bardy '414* as applied to claims 1, 21, 37 and 50 and further in view of *Kieval*. Claims 17-18 and 31-32 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Bardy '376* as applied to claims 1 and 21 and further in view of U.S. Publication No. 2004/0215258 to *Lovett et al.* (hereinafter "*Lovett*").

Three criteria must be met to establish a prima facie case of obviousness. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. Second, there must be a reasonable expectation of success. Finally, the prior art reference, or combination of references, must teach or suggest all the claim limitations. MPEP § 2142.

Each of claims 6, 7, 17, 18, 26, 27, 31, 32, 42, 43, 55, and 56 depend from one of independent claims 1, 21, 37, and 50, respectively. Independent claims 1, 21, 37, and 50 are not obvious for at least the reason that the cited references fail to teach or suggest each and every limitation recited in each claim. Furthermore, while the Applicant does not acquiesce with the particular rejections to these dependent claims, it is believed that these rejections are now moot in view of the remarks made in connection with independent claims 1, 21, 37, and 50. These dependent claims include all of the limitations of the base claim and any intervening claims, and recite additional features which further distinguish these claims from the cited reference. Moreover, if an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Therefore, dependent claims 6, 7, 17, 18, 26, 27, 31, 32, 42, 43, 55, and 56 are not made obvious by *Bardy '414* nor *Bardy '376*, even in combination with *Brockway*, *Kieval*, and *Lovett*.

As such, the Applicant respectfully requests withdrawal of the §103(a) rejection of claims 6, 7, 17, 18, 26, 27, 31, 32, 42, 43, 55, and 56 and notification that these claims are in condition for allowance.

For at least these reasons, the Applicant respectfully submits that the rejection of claims 6, 7, 17, 18, 26, 27, 31, 32, 42, 43, 55, and 56 as being made obvious by *Bardy* '414 or *Bardy* '376, in combination with *Brockway*, *Kieval*, and *Lovett*, is not sustainable.

It is to be understood that the Applicant does not acquiesce to the Examiner's characterization of the asserted art or the Applicant's claimed subject matter, nor of the Examiner's application of the asserted art or combinations thereof to the Applicant's claimed subject matter. Moreover, the Applicant does not acquiesce to any explicit or implicit statements or conclusions by the Examiner concerning what would have been obvious to one of ordinary skill in the art. The Applicant respectfully submits that a detailed discussion of each of the Examiner's rejections beyond that provided above is not necessary, in view of the clear absence of teaching and suggestion of various features recited in the Applicant's pending. The Applicant, however, reserves the right to address in detail the Examiner's characterizations, conclusions, and rejections in future prosecution.

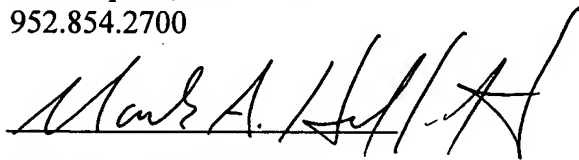
Authorization is given to charge Deposit Account No. 50-3581 (GUID.611PA) any necessary fees for this filing. If the Examiner believes it necessary or helpful, the undersigned attorney of record invites the Examiner to contact him to discuss any issues related to this case.

Respectfully submitted,

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